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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,047	10/29/2001	Yuan Gao	208-6164	1829

7590 08/20/2004  
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EXAMINER
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KALAFUT, STEPHEN J

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/040,047	<b>Applicant(s)</b> GAO ET AL. <span style="float: right;">S.C.</span>	
	<b>Examiner</b> Stephen J. Kalafut	<b>Art Unit</b> 1745	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-22,31-43,45-53,55-64,67-69,72,73,75-87 and 90-98 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 32-34,42,57-59,62-64,67-69,72,73,75-88 and 90-97 is/are allowed.  
 6) ☒ Claim(s) 2-22,31,35-41,43,45-53,55,56,60,61 and 98 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Claims 2-4, 6-22, 31, 36-39, 41, 43, 45-53, 55, 56, 61 and 98 are rejected under 35 U.S.C. 102(e) as being anticipated by Thackeray *et al.* (US 6,677,082), for reasons of record.

Claims 5 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thackeray *et al.*, for reasons of record.

Claims 35 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thackeray *et al.* in view of Saidi *et al.* (US 6,103,419), for reasons of record.

Claims 32-34, 42, 57-59, 62-64, 67-69, 72, 73, 75-88 and 90-97 are allowed. Claims 32-34, 42, 57-59 no longer depend on rejected claims. Claims 62-64, 67-69, 72, 73, 75-88 and 90-94 are free of the informalities giving rise to the previous rejection under §112. Claims 95-97 were allowed in the previous Office Action, of 3/16/2004. See pages 4 and 5 of that action, for the indications of allowable subject matter for all the presently allowed claims. The claims that were non-elected in response to the requirement of 10/1/2003 have been cancelled.

Applicant's arguments filed 6/16/2004 have been fully considered but they are not persuasive.

Applicants argue that Thackeray *et al.* do not disclose a material having more than a single-phase compound, and that therefore they do not disclose all of the limitations of the present claims rejected under §102, nor teach or suggest (along with Saidi *et al.*) all of the claimed limitations as required for a rejection under §103. This is not persuasive because the

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present claims do not require the present material to have more than one phase, and because, as applicants note, “domains of the two components exist side by side”, the “components” being the two compounds disclosed by Thackeray *et al.* Even if the limitation of more than one phase were read into the present claims, it would still not distinguish over Thackeray *et al.*, because there would still be no recitation of the sizes of the two phases or domains.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Kalafut whose telephone number is 571-272-1286. The examiner can normally be reached on Mon-Fri 8:00 am-4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sjk



STEPHEN KALAFUT  
PRIMARY EXAMINER  
GROUP

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